

**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**(Unpublished) Ex parte Jones, 62 USPQ2d 1206 (BdPatApp&Int 2001)**

**((Unpublished))**

**62 USPQ2D 1206**

**Ex parte Jones**

**U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences**

**Appeal No. 2001-1839  
Decided November 28, 2001**

**Unpublished Opinion**

(Non-precedential)

**Headnotes**

**PATENTS**

**[1] Patentability/Validity — Obviousness — Combining references (§115.0905)**

**“Motivation” to combine teachings of prior art is not always required to support obviousness rejection under 35 U.S.C. §103, since legally sufficient rationale for finding of obviousness may be supported by reason or suggestion in prior art, as well as motivation, to**

combine teachings.

**[2] Practice and procedure in Patent and Trademark Office —Board of Patent Appeals and Interferences — Rules and rules practice (§110.1105)**

**Patentability/Validity — Obviousness — Relevant prior art — In general (§115.0903.01)**

Patent examiner's citation of abstract in support of rejection without citation and reliance on underlying scientific article is generally inappropriate if both abstract and underlying document are prior art, and proper examination therefore should be based on underlying documents and translations, if necessary, since abstracts often are not written by author of underlying document, and may be erroneous; in present case, in which neither examiner nor applicant relies on underlying articles, Board of Patent Appeals and Interferences, in exercise of its discretion, will not obtain translations of underlying journal articles in order to evaluate merits of translations in first instance, since it is examiner's responsibility to obtain translations, and since review of translations by examiner and applicant may supply additional evidence as to whether there is legally sufficient reason, suggestion, teaching, or motivation to combine teachings of cited articles, and thus may eliminate need for appeal.

**Case History and Disposition**

Patent application of Jones, serial no. 08/947,428.1 Applicant appeals from examiner's rejection of claims 38 and 39 in application. Vacated and remanded.

[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion is not binding precedent of the board.]

**Judge:**

Before Winters and William F. Smith, administrative patent judges, and McKelvey, senior administrative patent judge.

**Footnotes**

1 Application for patent filed 8 October 1997.

**Opinion Text**

**Opinion By:**

McKelvey, S.J.

***Decision on appeal under  
35 U.S.C. § 134***

The appeal is from a decision of a primary examiner rejecting claims 38-39. We vacate and

remand for action not inconsistent with views expressed herein.

### *A. Findings of fact*

[§ 103(a)(2)] The record supports the following findings by at least a preponderance of the evidence.<sup>2</sup>

- [§ 103(a)(2)] 1. The claimed invention relates to a method of making organic chemicals.
- [§ 103(a)(2)] 2. The examiner has rejected claims 38-39 as being unpatentable under 35 U.S.C. §103(a) over

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- [§ 103(a)(2)] a) Horner,
- [§ 103(a)(2)] b) Suri,
- [§ 103(a)(2)] c) Endel'man,
- [§ 103(a)(2)] d) Manthey and
- [§ 103(a)(2)] e) Ota.

- [§ 103(a)(2)] 3. Horner is a 25-page technical journal article written in German.
- [§ 103(a)(2)] 4. The examiner has placed in the record a short English-language abstract of Horner.
- [§ 103(a)(2)] 5. The record does not contain an English-language translation of Horner.
- [§ 103(a)(2)] 6. Suri is a 2-page technical journal article written in English.
- [§ 103(a)(2)] 7. Endel'man is a 4-page technical journal article written in Russian.
- [§ 103(a)(2)] 8. The examiner has placed in the record a short English-language abstract of Endel'man.
- [§ 103(a)(2)] 9. The record does not contain an English-language translation of Endel'man.
- [§ 103(a)(2)] 10. Manthey is a 5-page technical journal article written in English.
- [§ 103(a)(2)] 11. Ota appears to be a 5-page technical journal article written in Japanese.
- [§ 103(a)(2)] 12. The examiner has placed in the record a short English-language abstract of Ota.
- [§ 103(a)(2)] 13. The record does not contain an English-language translation of Ota.

[§ 103(a)(2)] 14. The examiner does not maintain that any one of the five prior art references fully describes the claimed invention. Hence, a rejection based on 35 U.S.C. §103(a).

[§ 103(a)(2)] 15. According to the examiner, “the skilled artisan looking for an alternative route for the preparation” of the product produced by the claimed method “was deemed to be aware of all the various methods of the preparation” of the product (Examiner's Answer, page 4).

[§ 103(a)(2)] 16. Further according to the examiner, “one of ordinary skill in the art would be motivated [sic—would have been motivated] to prepare \*\*\* [the compound made by applicant's claimed method] by coupling

Suri's \*\*\* acid and Endel'man's \*\*\* acid as taught by Manthey followed by \*\*\* [further treatment] to yield \*\*\* [a compound] as taught by Horner and subsequent reduction as taught by Ota to arrive at the \*\*\* [claimed process]”(Examiner's Answer, pages 4-5).

17. According to applicant, the requisite “motivation” is not present in the prior art because “[t]hroughout the prosecution the examiner has failed to point out any teaching or suggestion in the prior art that would motivate the skilled artisan” to use the claimed process invention (Appeal Brief, page 4).

## B. Discussion

### 1. Rationale in support of obviousness

[1] The applicant and the examiner have apparently assumed that there always must be “motivation” to combine teachings of the prior art to support a rejection based on §103(a). The assumption is not correct. The word “motivation” or a word similar to “motivation” does not appear in 35 U.S.C. § 103(a). While a finding of “motivation” supported by substantial evidence probably will support combining teachings of different prior art references to establish a *prima facie* obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flathead screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flathead screws are viable alternatives serving the same purpose. Hence, the prior art would “suggest” substitution of flathead screws for Phillips head screws albeit the prior art might not “motivate” use of Phillips head screws in place of flathead screws.

What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a §103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some *teaching, suggestion* or *motivation* in the prior art to make the specific combination that was made by the applicant); *In re Gartside*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778 (Fed. Cir. 2000) (the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a *teaching* or *motivation* to combine prior art references); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*

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, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996) (“there must be a *reason, suggestion, or motivation* \*\*\* to combine [the teachings of] \*\*\* references \*\*\*”); *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention; the relevant inquiry is whether there is a *reason, suggestion, or motivation* in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references).

Moreover, when an examiner maintains that there is an explicit or implicit teaching or suggestion in the prior art, the examiner should indicate where (page and line or figure) such a teaching or suggestion appears in the prior art. *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), citing *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981).

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One difficulty with the rationale in support of the examiner's rejection in this case, and for that matter the applicant's challenge to the rejection, is that it appears to be based solely on a motivation rationale without taking into account whether there otherwise is a legally sufficient *reason, showing, suggestion or teaching* which might also suffice to support the examiner's rejection. Moreover, a suggestion, teaching or motivation to combine teachings of the prior art may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). *See also In re Gartside, supra* at 1319, 53 USPQ2d at 1778 (the suggestions may come from, *inter alia*, the teachings of the references themselves and, in some cases, from the nature of the problem to be solved).

If the examiner determines that it is appropriate to enter a further rejection, the examiner may wish to consider a rationale based on a suggestion, teaching or other reason in place of a rationale based exclusively on motivation.

We will also note that the examiner's theory of rejection, at least in part, seems to rely on the proposition that if a person of ordinary skill in the art is looking for an alternative method for the preparation of a compound, then that person would be aware of all analogous art (*see* Finding 15). If the examiner continues to rely on that theory, then the examiner would be under a burden to establish why a person of ordinary skill in the art would be looking for an alternative method, particularly where a method is known for making a particular compound.

## 2. Use of abstracts in place of underlying articles

The principal difficulty with the prosecution of the application on appeal is the examiner's attempt to establish "motivation" by reliance on three English-language abstracts of journal articles written in foreign languages. The examiner does not maintain that only Suri and Manthey, both in English, support the rejection. The use of abstracts, when the underlying document is prior art, gives us considerable pause.

The Board of Patent Appeals and Interferences continues to have recurring problems in resolving *ex parte* appeals which come before it. One continuing recurring problem is the citation and reliance by examiners on abstracts, without citation and reliance on the underlying scientific document.

[2] In this appeal, the examiner relied upon abstracts of three technical journal articles without referring to translations of the underlying documents. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. Abstracts often are not written by the author of the underlying document and may be erroneous. It is our opinion that a proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.

When an examiner cites and relies only on an abstract, the applicant may wish to obtain a copy of the underlying document and submit a copy to the examiner when responding to a rejection relying on an abstract. In the event a reference is in a foreign language, if the applicant does not wish to expend resources to obtain a translation, the applicant may wish to request the examiner to supply a translation. If

a translation is not supplied by the examiner, the applicant may wish to consider seeking supervisory relief by way of a petition (37 CFR § 1.181) to have the examiner directed to obtain and supply a translation.

In the past, when neither the examiner nor the applicant relies on the underlying article, the board often expended the resources necessary to obtain a copy of the underlying scientific article, as well as translations thereof. When it did so, however, the burden of examining the application fell on the board in the first instance. Moreover, to the extent that the board relies on parts of a translation not previously provided to an applicant, any affirmance generally has to be a new ground of rejection under 37 CFR § 1.196(b)—which can result in further prosecution.

In this case, we do not know whether the examiner or the applicant had or reviewed the underlying foreign language technical journal articles or translations thereof. The board cannot examine, in the first instance, all applications which come before it in an *ex parte* appeal under 35 U.S.C. § 134. In this particular appeal, we exercise discretion by declining to obtain translations of the underlying technical journal articles and thereafter evaluate on the merits in the first instance the translations. In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings of the five technical journal articles. Moreover, an evaluation of translations may eliminate the need for an appeal.

### C. Decision

The decision of the examiner rejecting claims 38-39 under 35 U.S.C. § 103(a) over (1) Horner, (2) Suri, (3) Endel'man, (4) Manthey and (5) Ota is *vacated* and the application is *remanded* to the examiner. For the effect of a decision vacating an examiner's rejection, see *In re Zambrano*, 58 USPQ2d 1312 (Bd. Pat. App. & Int. 2001) (explaining that vacated rejection no longer exists).

The examiner and/or the applicant may obtain translations of (A) Horner, (B) Endel'man and (C) Ota.

Nothing in this opinion should be read as precluding the examiner from entering a rejection based on translations. In the event the examiner determines that claims 38-39 are unpatentable over the combination of the five references (or any additional prior art), then the examiner must identify and cite the specific portions (page and line or figure) of each article or prior art document upon which he relies in support of any rejection. We are primarily a board of review. Accordingly, neither the examiner nor applicant should expect in any further appeal for us to dig through five prior art references to come up with a theory which might support or negate a rejection in the first instance. Moreover, if the examiner enters a further rejection based on foreign language document, translations must be obtained if a further appeal is taken. We will not decide a further appeal without translations.

We express no views on the ultimate merits of any rejection under 35 U.S.C. § 103(a) based on the five prior art references or any additional prior art which the examiner and applicant may wish to make of record.

### D. Order

Upon consideration of the appeal, and for the reasons given, it is

ORDERED that the examiner's rejection under §103(a) of claims 38-39 is *vacated*.

FURTHER ORDERED that the application is *remanded* to the examiner for action not inconsistent with the views expressed in this opinion.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

*VACATED and REMANDED*

**Footnotes**

2 To the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

**- End of Case -**